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Before the Board of Patent Appeals and Interferences

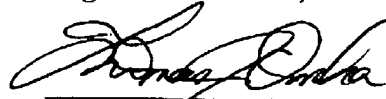
In re the Application

Inventor : **Adolf Proidl et. al.**
Application No. : **10/015,836**
Filed : **November 30, 2001**
For: **RECORDING ARRANGEMENT FOR THE ERROR-TOLERANT
RECORDING OF AN INFORMATION SIGNAL**

APPEAL BRIEF

On Appeal from Group Art Unit 2621

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Date: May 31, 2008

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I. REAL PARTY IN INTEREST

The real party in interest is the assignee of the present application, Koninklijke Philips Electronics N.V., and not the party named in the above caption.

II. RELATED APPEALS AND INTERFERENCES

With regard to identifying by number and filing date all other appeals or interferences known to Appellants which will directly effect or be directly affected by or have a bearing on the Board's decision in this appeal, Appellants are not aware of any such appeals or interferences.

III. STATUS OF CLAIMS

Claims 1-13 stand finally rejected and are the subject matter of this appeal.

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IV. STATUS OF AMENDMENTS

In response to the Final Office Action, dated January 2, 2008, Appellants timely submitted, on February 27, 2008, arguments believed to overcome the reasons for rejecting the claims. No claim amendments were submitted at that time. On March 31, 2008, an Advisory Action was entered into the record. The Advisory Action stated that the response did not place the application in a condition for allowance. A Notice of Appeal was filed on April 2, 2007 in response to the Advisory Action and this Appeal Brief is being filed within the period of response from the date of the Notice of Appeal.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

Independent claim 1 recites a recording arrangement (Fig. 1, item 1) for the error-tolerant recording of an information signal (Fig. 1, item FS) of an information broadcast programmed for recording and identified by a broadcast identification (VPS-P1) and a broadcast start time (SBZ-P1) (these terms are discussed in paragraph [0039] and examples of which are depicted in Fig. 2), having

receiving means (Fig. 1, item 4) for receiving the information signal (FS) in which information broadcasts and associated broadcast identifications ("VPS-SI" depicted in Fig. 1 and discussed in paragraph [0029]) can be transmitted, and having

recording means (Fig. 1, item 6) for recording the received information signal (FS) on a record carrier (Fig. 1, item 8) in a recording mode of the recording arrangement (Fig. 1, item 1), and having

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recording control means (Fig. 1, item 11) for evaluating both the broadcast identification (VPS-PI, VPS-SI) of the programmed information broadcast being detected in the information signal (FS) and a recording start time ("ABZ" as described in paragraph [0033]; examples of which are provided in Fig. 2) of the programmed information broadcast being reached, which recording start time is reached a lead time interval ("VZ as discussed in paragraph [0033])) before the broadcast start time (SBZ-PI) of the programmed information broadcast; and for activating the recording mode at the first occurrence of either the broadcast identification or the recording start time (see paragraph [0034].

Independent claim 12 recites a method similar to the arrangement of claim 1. In particular, claim 12 recites a recording method for the error-tolerant recording of an information signal (FS) of an information broadcast programmed for recording and identified by a broadcast identification (VPS-PI) and a broadcast start time (SBZ-PI) (the VPS-PI and SBZ-PI terms are each discussed in paragraph [0039] and examples of which are depicted in Fig. 2), in which the following steps are performed:

receiving (Fig. 1, item 4) the information signal (FS) in which information broadcasts and associated broadcast identifications (VPS-SI) can be transmitted;

evaluating both the broadcast identification (VPS-PI, VPS-SI) of the programmed information broadcast being detected in the information signal (FS) and a recording start time (ABZ) of the programmed information broadcast, which recording start time is reached a lead time interval (VZ) before the broadcast start time (SBZ-PI) of the programmed information broadcast; and,

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recording the received information signal (FS) when a recording mode is active;
and,
activating the recording mode at the first occurrence of either the broadcast
identification (VPS-PI, VPS-SI) of the programmed information broadcast being detected
in the information signal (FS) or a recording start time (ABZ) of the programmed
information broadcast being reached (see paragraph [0034]).

VI. GROUND FOR REJECTION TO BE REVIEWED ON APPEAL

The issue in the present matter is whether:

1. Claims 1-13 are unpatentable under 35 USC 103(a) over Hennig, U.S. Pat. No. 5,956,455 (Hereinafter "Hennig") in view of Jackson, U.S. Pat. No. 5,963,264 (Hereinafter "Jackson").

VII. ARGUMENT

I. 35 USC §103 Rejection of Claims 1-13

Claims 1-13 are not unpatentable over Hennig in view of Jackson under 35 USC 103(a), as the combination of Hennig and Jackson fails to show material elements recited in the independent claim.

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Appellants respectfully submit that the pending claims are patentable for at least the following reasons.

The present invention as defined by claim 1 (and corresponding claim 12) essentially recites that recording of a broadcasted signal commences when the first of the following evaluated events occurs:

- the broadcast identification (VPS-PI, VPS-SI) of the programmed information broadcast being detected
- a recording start time (ABZ) of the programmed information broadcast being reached

In addition, claim 1 (and corresponding claim 12) recites that the recording start time (ABZ) is reached at a lead time interval (VZ) before the broadcast start time (SBZ-PI) of the programmed information broadcast.

It is respectfully submitted that in order to establish a *prima facie* case of obviousness, three basic criteria must be met:

1. there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings;
2. there must be a reasonable expectation of success; and
3. the prior art reference must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, and not based on

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applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20
USPQ2d 1438 (Fed. Cir. 1991)

Hennig teaches a videocassette recorder which includes VPS and VPT automatic programming which "continuously compares preprogrammed VPS data to incoming VPS time codes for the currently running program, and to VPS program schedule information" (Abstract). Jackson describes a method and apparatus for controlling all models of VCRs via infrared signals by providing the infrared (IR) codes necessary to operate each particular brand and model VCR and for activating a VCR by saturating the local area with high powered, broadcasted IR signals.

Neither Hennig nor Jackson, either singly or in combination, teaches the use of a recording start time defined as a lead time interval before the broadcast start time of the programmed information broadcast. Further, the combination of Hennig and Jackson fails to disclose the limitation of activating the recording mode as a condition of such a determined recorded start time, as recited in claim 1.

The Examiner fails to properly address these features in the rejection of claim 1 based on the combination of Hennig and Jackson. By way of example, the Final Office Action's rejection simply states "which recording start time is reached a lead time interval before the broadcast start time of the programmed information broadcast" (Final Office Action at page 5, lines 4-6). What if any lead time is being referenced is unclear. This Office Action does reference Fig. 4a of Hennig in which a "lag time" appears

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applicable – a delay resulting from a sporting event running overtime. However, Hennig, either singly or in combination with Jackson, fails to teach or suggest the feature of the present invention whereby recording will commence at a recording start time (ABZ) which is defined in the claim as being reached at a lead time interval (VZ) before the broadcast start time.

The final Office Action (page 3, last line – page 4, lines 1-3) makes the following remarks in response to Appellants' arguments contained in his October 9, 2007 amendment:

Jackson discloses the recording process begins when the programming selection is actually aired [emphasis added]. ... (see col. 5 line 51-col. 6 line 20 and Fig. 2). Jackson in fact teaches beginning a recording process when a program [sic] aired not necessarily when it was originally scheduled to begin. Jackson teaches recording will [emphasis added] commence at a recording start time which is a lead time before the broadcast start time.

As an initial matter the emphasized term “will” improperly characterizes Jackson for as noted in the above section itself, recording begins when the program is broadcast. While there may very well be some scenarios in which recording may occur prior to the originally scheduled broadcast time, such a change occurs as a result of monitoring “the data 29 downlinked signals 3 to determine when the programming selection corresponding to an EPG selection 7 begins” (Jackson at col. 5, lines 56-58) -- not as the result of a lead time interval (VZ) before the scheduled broadcast start time (SBZ-PI) (where the term SBZ-PI is defined as being the expected broadcast start time). Further, the recording start time ABZ is defined in paragraph [0039] as being the time entered

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during the recording scheduler mode (see also Fig. 2). The teachings of Jackson referenced above relate to situations occurring at the time of broadcast and have nothing to do with the claimed lead time interval utilized at the time of recording scheduling.

Appellants' prior submissions have contained discussion of the rationale for the "lead time interval" feature and how under various scenarios the claimed invention arguably would properly record a program scheduled with improper VPS time information, while the Hennig/Jackson combination would not. The Office Actions would argue that the Hennig/Jackson combination would properly record programs having improper VPS time information. For various reasons, Appellants do not concede the validity of the examiner's arguments contained in these Office Actions as to this issue – the two inventions yield different results under certain circumstances. Further, the Hennig/Jackson combination requires the originally incorrect VPS codes be changed at some point prior to the broadcast and/or a constant monitoring be maintained. The problems associated with the Hennig/Jackson approaches (that are overcome by the current invention) were discussed in the present invention's specification:

It has proved to be a drawback of the known recording arrangement and the known recording method that, unfortunately, incorrect VPS codes in the program information from the television station are corrected only rarely, as a result of which television broadcasts that are programmed with a broadcast identification, such as the VPS code, are often not recorded at all. Furthermore, the power consumption of the known video recorder is comparatively high as a result of the periodic scanning and testing of the program information. Therefore, a "low-power standby mode", which is greatly appreciated by users, cannot be realized with the known video recorder [0006].

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Moreover, of greater significance with respect to patentability is that fact noted above -- that neither Hennig nor Jackson, either singly or in combination, teaches the use of a recording start time defined as a lead time interval before the broadcast start time of the programmed information broadcast. Further, the combination of Hennig and Jackson fails to disclose the limitation of activating the recording mode as a condition of such a determined recorded start time, as recited in claims 1 and 12.

Appellants wish to address an additional matter contained in the very last sentence of the Advisory Action: "the te [sic] USPTO considers the Applicant's "or" language to be anticipated by any reference containing one of the subsequent corresponding elements." The word "or" does appear in the very last line of claim 1 (and similarly in claim 12). However, it is part of a phrase "at the first occurrence of either X or Y" where X and Y were conditions evaluated earlier in the claim. Appellants submit that the use of "or language" in such a phrase is not categorically "anticipated by any reference containing one of the subsequent corresponding elements." That is, in such a claim both X and Y elements need to be evaluated to determine which is the first to occur, and both X and Y elements must be capable of being selected as the first. The presence of only one subsequent element thus fails to meet the language of the claim.

Having shown that the combined device resulting from the teachings of the cited references does not include all the elements of the present invention, Appellants submit that the reasons for the examiner's rejections of the claims have been overcome and can

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no longer be sustained. Appellants respectfully request reconsideration, withdrawal of the rejection and allowance of the claims.

In the matter of obviousness there is a great emphasis placed on "the importance of the motivation to combine." For example, the court in Yamanouchi Pharmaceutical Co. v. Danbury Pharmacal, Inc. 231 F. 3d. 1339, 56 USPQ2d. 1641, 1644 (Fed. Cir. 2000) found that:

an examiner ... may often find every element of a claimed invention in the prior art. If identification of each claimed element of the prior art was sufficient to negate patentability, very few patents would ever issue. Furthermore rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner ... to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention ... To counter this potential weakness in the obviousness construct, the suggestion to combine requirements stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness. *id.* quoting *In re Rouffet*, 149 F.3d 1350, 1357-58, 47 USPQ 2d 1453, 1457 (Fed. Cir. 1998)

In this case, Appellants believe that with regard to the referred-to claims, the examiner has impermissibly incorporated the teachings of the present invention in the cited reference to reject the claims. Accordingly, Appellants submit that the reasons for the examiner's rejections of the claims have been overcome and the rejection can no longer be sustained. Appellants respectfully request reconsideration, withdrawal of the rejection and allowance of the claims.

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In view of the foregoing discussion, the Office Action has failed to make out a *prima facie* case of obviousness, instant independent claims 1 and 12 are allowable, and the rejection should be withdrawn. In particular, since the combination of Hennig and Jackson, fails to teach or suggest each and every feature of the claims as required by 35 U.S.C. 103(a), Appellants respectfully submit that claims 1 and 12 are allowable.

II. 35 USC §103 Rejection of Claims 3-8, 10 and 11

With regard to the dependent claims 1-11 and 13, these claims ultimately depend from one of independent claims 1 or 12. Appellants respectfully submit that these dependent claims are allowable at least for their dependence upon allowable base claim, without even contemplating the merits of the dependent claims for reasons analogous to those held in *In re Fine*, 837 F.2d 1071, 5 USPQ 2d 1596 (Fed. Cir. 1988) (if an independent claim is non-obvious under 35 U.S.C. §103(a), then any claim depending therefrom is non-obvious).

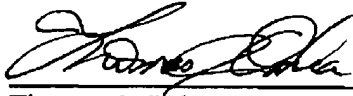
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VIII. CONCLUSION

In view of the above analysis, it is respectfully submitted that the referenced teachings fail to render unpatentable or anticipate the subject matter of any of the present claims. Therefore, reversal of all outstanding grounds of rejection is respectfully solicited.

Respectfully submitted,
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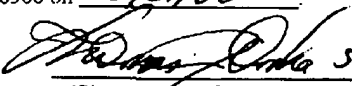
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VIII. CLAIMS APPENDIX

The claims which are the subject of this Appeal are as follows:

1. A recording arrangement (1) for the error-tolerant recording of an information signal (FS) of an information broadcast programmed for recording and identified by a broadcast identification (VPS-PI) and a broadcast start time (SBZ-PI), having
receiving means (4) for receiving the information signal (FS) in which information broadcasts and associated broadcast identifications (VPS-SI) can be transmitted, and having
recording means (6) for recording the received information signal (FS) on a record carrier (8) in a recording mode of the recording arrangement (1), and having
recording control means (11) for evaluating both the broadcast identification (VPS-PI, VPS-SI) of the programmed information broadcast being detected in the information signal (FS) and a recording start time (ABZ) of the programmed information broadcast being reached, which recording start time is reached a lead time interval (VZ) before the broadcast start time (SBZ-PI) of the programmed information broadcast; and for activating the recording mode at the first occurrence of either the broadcast identification or the recording start time.
2. A recording arrangement (1) as claimed in claim 1, in which the end of the programmed information broadcast is defined by a broadcast end time (SEZ-PI) and in which the recording control means (6) are adapted to deactivate the recording mode when both the absence of the broadcast identification (VPS-PI, VPS-SI) of the programmed information broadcast is detected and a recording end time (AEZ) of the programmed information broadcast is reached, which recording end time is reached a trailing time interval (NZD) after the broadcast end time (SEZ-PI) of the programmed information broadcast.

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3. A recording arrangement (1) as claimed in claim 1, in which marking means (11) are provided, which marking means are adapted, in the recording mode of the recording arrangement (1), to store marking information (MI) defining the current recording position (API) on the record carrier (8) when the broadcast identification (VPS-SI) received in the information signal (FS) changes.

4. A recording arrangement (1) as claimed in claim 1, in which offline analysis means (11) are provided, which analysis means are adapted, after deactivation of the recording mode, to analyze the recorded information signal (WFS) and to mark information signal portions of the recorded information signal (WFS) which have common characteristics with marking information (MI), the characteristics to be analyzed being, for example, a picture frequency, velocity information of objects of the picture content, text information of the picture content, color information of the picture content or sound information of the recorded information signal (WFS).

5. A recording arrangement (1) as claimed in claim 3 or claim 4, in which the offline analysis means (11) are adapted to define stored marking information (MI) as a reproduction start position (WBP) and/or to define stored marking information (MI) as a reproduction end position (WEP) of the information broadcast recorded in the recording means (6).

6. A recording arrangement (1) as claimed in claim 1, in which the recording control means (11) are adapted to activate the recording mode when the broadcast identification (VPS-PI) of the information broadcast transmitted before the programmed information broadcast is no longer detected in the sequence of broadcast identifications (VPS-SI) included in the received information signal (FS).

7. A recording arrangement (1) as claimed in claim 1, in which the recording control means (11) are adapted to deactivate the recording mode when the broadcast identification (VPS-PI) of the information broadcast transmitted after the programmed

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information broadcast is already detected in the sequence of broadcast identifications (VPS-SI) included in the received information signal (FS).

8. A recording arrangement as claimed in claim 1, in which further receiving means for receiving a further information signal are provided, in which further information signal further programmable information broadcasts and associated broadcast identifications can be transmitted.

9. A recording arrangement (1) as claimed in claim 1, in which recording scheduler means (10, 11, 14) are provided by which an information broadcast to be recorded can be programmed and which are adapted to evaluate electronic program information (PI) received by the receiving means (4), which electronic program information includes both broadcast start times (SBZ) and the expected sequence of broadcast identifications (VPS-PI) of the information broadcasts to be expected in the information signal (FS) to be recorded.

10. A recording arrangement (1) as claimed in claim 1, in which the record carrier (8) takes the form of a hard disk.

11. A recording arrangement (1) as claimed in claim 1, in which the recording control means include VPS decoder means (13) for decoding a VPS code which forms the broadcast identification.

12. A recording method for the error-tolerant recording of an information signal (FS) of an information broadcast programmed for recording and identified by a broadcast identification (VPS-PI) and a broadcast start time (SBZ-PI), in which the following steps are performed:

receiving the information signal (FS) in which information broadcasts and associated broadcast identifications (VPS-SI) can be transmitted;

evaluating both the broadcast identification (VPS-PI, VPS-SI) of the programmed information broadcast being detected in the information signal (FS) and a recording start

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time (ABZ) of the programmed information broadcast, which recording start time is reached a lead time interval (VZ) before the broadcast start time (SBZ-PI) of the programmed information broadcast; and,

recording the received information signal (FS) when a recording mode is active; and,

activating the recording mode at the first occurrence of either the broadcast identification (VPS-PI, VPS-SI) of the programmed information broadcast being detected in the information signal (FS) or a recording start time (ABZ) of the programmed information broadcast being reached.

13. A recording method as claimed in claim 12, in which the end of the programmed information broadcast is defined by a broadcast end time (SEZ-PI) and in which the recording mode is deactivated when both the absence of the broadcast identification (VPS-PI, VPS-SI) of the programmed information broadcast is detected and a recording end time (AEZ) of the programmed information broadcast is reached, which recording end time is reached a trailing time interval (NZ) after the broadcast end time (SEZ-PI) of the programmed information broadcast.

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X. EVIDENCE APPENDIX

No further evidence is provided.

XI. RELATED PROCEEDING APPENDIX

No related proceedings are pending and, hence, no information regarding same is available.